

PATENTAtty Docket No.: 10980251-1
App. Ser. No.: 09/483,183**REMARKS**

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

Claims 1-29 are currently pending, of which claims 1, 11, 12, 18, 19, and 25 are independent. Claims 1, 11, 12, 18, 19, and 25 have been amended. Support for the amendments may be found on page 7 lines 7-25 and page 8 lines 5-15. Claims 30-31 have been canceled without prejudice or disclaimer of the subject matter therein.

No new matter has been introduced by way of the claim amendments; entry thereof is therefore respectfully requested.

Claim 1 was rejected under U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement.

Claims 1, 3-5, 9-10, 19, 23, 26, 29-30 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi (6,181,436) (hereinafter ("Kurachi") in view of Anvret et al. (5,307,411) (hereinafter "Anvret"). At the outset, the Applicants note that the Davis reference, cited below, is included in the body of this rejection in the Office Action. However, it appears that Davis was only relied on by the Examiner as allegedly providing teachings of the features of claims 26 and 29. The Applicants respectfully request clarification of the status of claims 1, 3-5, 9-10, 19, 23, and 30, with respect to Davis.

Claims 2 and 22 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Furman (5,483,653) (hereinafter "Furman"). It appears that claim 22 was rejected twice; both here and in further view of Boyles, as set forth below. The Applicants respectfully request clarification of the status of claim 22.

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Claim 6 was rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Mazzagatte et al. (6,862,583) (hereinafter "Mazzagatte").

Claims 7-8 and 20 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Peairs (5,717,940) (hereinafter "Peairs").

Claims 11 and 21-22 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret, Furman and Boyles (6,738,901) (hereinafter "Boyles").

Claim 27 was rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret, Furman, Boyles, and Davis (5,568,552) (hereinafter "Davis").

Claims 18 and 24-25 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Davis.

Claims 12-13 and 15-16 were rejected under U.S.C. §103(a) as allegedly being obvious over Mazzagatte in view of Kurachi and Anvret.

Claim 14 was rejected under U.S.C. §103(a) as allegedly being obvious over Mazzagatte in view of Kurachi, Anvret, and Peairs.

Claim 17 was rejected under U.S.C. §103(a) as allegedly being obvious over Mazzagatte in view of Kurachi, Anvret, Furman, and Boyles.

Claim 28 was rejected under U.S.C. §103(a) as allegedly being obvious over Mazzagatte in view of Kurachi, Anvret, and Davis.

Claim 31 was rejected under U.S.C. §103(a) as allegedly being obvious over Mazzagatte in view of Kurachi, Anvret, and Savage.

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App. Ser. No.: 09/483,183**Claim Rejection Under 35 U.S.C. §112, first paragraph**

Claim 1 has been rejected for allegedly not complying with the written description requirement. Claim 1 has been amended to include that "the identity includes at least one cryptographic key contained on the smart card." Therefore, the printer does not have the identity until the key is given. Support for this feature may be found on page 8, lines 7-16 of the originally filed specification, which describes the printer not having the identity until the identity is provided by the smart card.

Therefore, claim 1 complies with the written description requirement and withdrawal of the rejection is respectfully requested.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.
In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

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Claims 1, 3-5, 9-10, 19, 23, 26, 29-30 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret. Davis is included in the body of this rejection in the Office Action; however, Davis appears to have been applied only to claims 26 and 29. Therefore, this response will treat claims 1, 3-5, 9-10, 19, and 23 as rejected over Kurachi and Anvret alone.

Kurachi and Anvret fail to teach or suggest each and every element of independent claim 1, and the claims that depend therefrom. Specifically, Kurachi and Anvret fail to teach or suggest at least "placing an order for the encrypted document," as recited in independent claim 1. In contrast to this claimed feature, Kurachi discloses placing an order for an unencrypted document, which is later encrypted. See Figure 9 of Kurachi. Anvret fails to cure the deficiencies of Kurachi because Anvret is silent with respect to ordering any type of document. Similarly, the prior art of record also fails to cure the deficiencies of Kurachi and Anvret.

Kurachi and Anvret fail to teach or suggest "establishing a connection between the server and the printer to which the encrypted document will be distributed after the order is placed," as recited in independent claim 1. The printers of Kurachi are in constant connection with the computers containing print data before any print order is placed. Anvret fails to cure the deficiencies of Kurachi because Anvret is silent with respect to ordering any type of document. Similarly, the prior art of record also fails to cure the deficiencies of Kurachi and Anvret.

Kurachi and Anvret fail to teach or suggest using a "smart card to give an identity to the printer within a predetermined amount of time of the establishing of the connection," as recited in independent claim 1. As acknowledged in the Office Action, Kurachi fails to teach

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or suggest the use of a smart card. In fact, Kurachi is silent with respect to the method by which the printer receives the encryption key. Anvret merely discloses the general use of smart card and fails to teach or suggest the need for a smart card to provide an identity within a predetermined amount of time. Similarly, the prior art of record also fails to cure the deficiencies of Kurachi and Anvret.

Kurachi and Anvret fail to teach or suggest "the printer not having the identity until the identity is given," as recited in independent claim 1. Claim 1 further recites "wherein the identity includes at least one cryptographic key contained on the smart card." In contrast to the claimed feature, Kurachi discloses the printer having the key throughout the entire process. In fact, the first step in Kurachi's method is the printer sending the key to the computer system containing the documents. See column 13, lines 45-50. As Kurachi explains, the key is required to be sent from the printer to begin the encryption process. Therefore, it would not have been obvious to modify Kurachi to include a printer not having the identity until it is given, because to do so would destroy the functionality of Kurachi's method. If the printer of Kurachi did not have the key initially, Kurachi's printing process could not begin.

Kurachi and Anvret fail to teach or suggest "the server times out, the server closes the connection established with the printer, and the server cancels the placed order if the smart card fails to give the identity to the printer within the predetermined amount of time" and establishing "the printer identity with the server in response to the smart card giving the identity to the printer within the predetermined amount of time." This feature provides the system with increased security. Kurachi and Anvret are silent with respect to a server performing these functions. The Office Action cites Savage as providing a general teaching

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of timeouts. However, Savage only teaches timeouts between two servers when one server fails to communicate with another server. The claims, however, recite a server communicating with a printer and the server not only timing out, but also closing the connection established with the printer and canceling the print order. The server of the claims performs these three functions, not merely, in response to not receiving a communication, but in response to the smart card not giving the identity to the printer within the predetermined amount of time.

Therefore, the prior art of record fails to teach or suggest the elements of independent claim 1. Accordingly, claim 1 and the claims that depend therefrom, 2-10 and 26, are allowable over the prior art of record, and withdrawal of the rejection of these claims is respectfully requested.

With respect to claim 19, Kurachi, Anvret, and the prior art of record fail to teach or suggest "a network interface for receiving a print order for an encrypted document and for establishing a network connection with the document server after the print order is received," for the reasons discussed above.

Similarly, Kurachi, Anvret, and the prior art of record fail to teach or suggest "the document server times out, the document server closes the connection established with the network printer, and the document server cancels the print order for the encrypted document if the identity is not established within the predetermined amount of time," as recited in claim 19, for the reasons set forth above.

Therefore, the prior art of record fails to teach or suggest the elements of independent claim 19. Accordingly, claim 19 and the claims that depend therefrom, 20-23 and 29, are

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allowable over the prior art of record, and withdrawal of the rejection of these claims is respectfully requested.

Claims 2 and 22

Claims 2 and 22 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Furman. Due to the confusion over the rejection of claim 22, claim 22 will be discussed with respect to both Furman and Boyles.

Initially, claims 2 and 22 are both allowable, at least, by virtue of their dependence upon allowable claims 1 and 19, for the reasons set forth above. Additionally, claims 2 and 22 are allowable over the prior art of record because the prior art of record fails to teach or suggest the encrypted document including a message containing print information. The Office Action concedes that this feature is not taught by either Kurachi or Anvret. Also, both Furman and Boyles fail to teach or suggest this feature, because Furman and Boyles disclose print information contained in a separate message, not associated with a document to be printed. Therefore, the prior art of record fails to teach or suggest an encrypted document containing a message having print information.

Claim 6

Claim 6 is rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Mazzugatte.

Claim 6 is allowable, at least, by virtue of its dependence upon allowable claim 1, for the reasons set forth above.

PATENTAtty Docket No.: 10980251-1
App. Ser. No.: 09/483,183Claims 7-8 and 20

Claims 7-8 and 20 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Peairs.

Claims 7-8 and 20 are allowable, at least, by virtue of their dependence upon allowable claims 1 and 19, for the reasons set forth above.

Claims 11 and 21-22

Claims 11 and 21-22 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret, Furman and Boyles.

Independent claim 11 recites features similar to the features of independent claim 1. For instance, claim 11 includes "placing an order for the encrypted document to be distributed to the printer;

establishing a connection between the server and the printer to which the encrypted document will be distributed, after the order is placed;" and

"the server times out, the server closes the connection established with the printer, and the server cancels the placed order if the printer fails to give the printer identity to the server within the predetermined amount of time." These features are not taught or suggested by Kurachi and Anvret for the reasons set forth above. Furman and Boyles both fail to cure the deficiencies of Kurachi and Anvret.

Therefore, the prior art of record fails to teach or suggest the elements of independent claim 11. Accordingly, claim 11 and the claim that depends therefrom, 22, are allowable over the prior art of record, and withdrawal of the rejection of these claims is respectfully requested.

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Additionally, claim 21 is allowable, at least, by virtue of its dependence upon allowable claim 19, for the reasons set forth above.

Claim 27

Claim 27 is rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret, Furman, Boyles, and Davis (S,§68,§52) (hereinafter "Davis").

Claim 27 is allowable, at least, by virtue of its dependence upon allowable claim 11, for the reasons set forth above.

Claims 18 and 24-25

Claims 18 and 24-25 were rejected under U.S.C. §103(a) as allegedly being obvious over Kurachi in view of Anvret and Davis.

With respect to independent claim 18, the combination of Kurachi, Anvret, and Davis fails to teach or suggest "means for establishing a connection with a remote site over a network, wherein the remote site includes a server storing an encrypted document, and wherein the connection is established after an order for the encrypted document is placed;" and "means for communicating the printer identity to the server within a predetermined amount of time of establishing the connection with the remote site, wherein the server times out, the server cancels the order for the encrypted document, and the server closes the connection established with the network printer if the network printer fails to give the printer identity to the server within the predetermined amount of time." These features are similar to features recited in independent claim 1. Therefore, Kurachi and Anvret fail to teach or suggest these features for the reasons cited above. Davis is relied on in the Office Action

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only for an alleged teaching of authenticating with tokens. Davis, therefore, fails to cure the deficiencies of Kurachi and Anvret.

Accordingly, allowance of claim 18 and the claim that depends therefrom, 24, is respectfully requested, because the prior art of record fails to teach or suggest the elements of independent claim 18.

With respect to independent claim 25, the combination of Kurachi, Anvret, and Davis fails to teach or suggest a server “storing an encrypted document comprising:

means for receiving a print order for the encrypted document;” and

“means for closing the connection established with the remote network printer and canceling the print order for the encrypted document if the server fails to receive the cryptographic key from the remote network printer within the predetermined amount of time.” These features are similar to features recited in independent claim 1. Therefore, Kurachi and Anvret fail to teach or suggest these features for the reasons cited above. Davis is relied on in the Office Action only for an alleged teaching of authenticating with tokens. Davis, therefore, fails to cure the deficiencies of Kurachi and Anvret.

Accordingly, allowance of claim 25 is respectfully requested, because the prior art of record fails to teach or suggest the elements of independent claim 25.

Claims 12-13 and 15-16

Claims 12-13 and 15-16 are rejected under U.S.C. §103(a) as allegedly being obvious over Mazzagatte in view of Kurachi and Anvret.

The combination of Mazzagatte, Kurachi, and Anvret fails to teach or suggest each and every element of independent claim 12. For instance, the prior art of record fails to teach

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or suggest at least "a client machine connected to the network for placing an encrypted document order," as recited in claim 12. Contrary to the claim language, Mazzagatte discloses ordering non-encrypted documents to be printed and then later encrypting the documents. See Figure 5 of Mazzagatte, for example. Kurachi and Anvret fail to cure the deficiencies of Mazzagatte, as set forth above.

The combination of Mazzagatte, Kurachi, and Anvret also fails to teach or suggest "the server being programmed to send at least one encrypted document to the printer after the encrypted document order has been placed and the printer identity has been established, wherein the server times out, the server closes the connection established with the printer, and the server cancels the encrypted document order if the printer fails to give the identity to the server within the predetermined amount of time," as recited in claim 12. Mazzagatte is silent with respect to these features.

The Office Action cites Savage as providing a general teaching of timeouts. However, as set forth above, Savage only teaches timeouts between two servers when one server fails to communicate with another server. Claim 12, however, recite a server not only timing out, but also closing the connection established with the printer and canceling the print order. The server of claim 12 performs these three functions, not merely, in response to not receiving a communication, but in response to the printer failing to give the identity to the server within the predetermined amount of time.

Therefore, the prior art of record fails to teach or suggest the elements of independent claim 12. Accordingly, claim 12 and the claims that depend therefrom, 13-17 and 28, are allowable over the prior art of record, and withdrawal of the rejection of these claims is respectfully requested.

PATENTAtty Docket No.: 10980251-1
App. Ser. No.: 09/483,183Claims 14, 17, and 28

Claims 14, 17, and 28 are allowable, at least, by virtue of their dependence upon allowable claim 12, for the reasons set forth above.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: July 19, 2006

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